



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/417,399 10/13/99 HUBERMAN S MBI-1036

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EXAMINER

RIMELL, S

ART UNIT

PAPER NUMBER

3712

DATE MAILED:

09/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/417,399

Applicant(s)

HUBERMAN ET AL.

Examiner

Sam Rimell

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3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-18 and 20-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-18 and 20-35 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
- ☐ received.
 - ☐ received in Application No. (Series Code / Serial Number) ____.
 - ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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Claims 27-28 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 27 repeats limitations already recited in claim 26 from which it depends.

Claims 1-14, 16-18, and 20-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase “sized and dimensioned to be comfortably inserted into an infant’s mouth” is indefinite, since the size of an infant’s mouth can vary considerably.

In claim 3, the phrase “integrated into said artwork” is vague and indefinite.

In claim 13, the phrase “sufficiently weighted” is indefinite.

In claim 14, the phrase “gripping means comprising teething means” is indefinite and contradictory

In claim 18, the phrase “leaf weight means comprising teething means” is indefinite and contradictory.

In claim 26, the phrase “being sized and dimensioned to be comfortably inserted into an infant’s mouth” is vague and indefinite, as the size of an infant’s mouth can vary considerably.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 12-21 and 22-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Lomas.

Lomas discloses a paper stack having a plurality of leaves, and an element (10) attached to all of the leaves in the stack. The element is physically capable of being teathed. The element is elastomeric and a result of expandable folds incorporated into element. The expandable folds also read as texturing on the surface of the element. Any printed matter which is printed on the leaves may be read as "artwork". The leaves are flexible and thin, and thus read as a "cloth-like" material. This claim language does not explicitly require the existence of cloth.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lomas.

Lomas differs from claims 9 and 10 in that the element shown by Lomas is not attributed a specific size. However, forming the element with the sizes recited in claims 9 and 10 would have been obvious to one of ordinary skill in the art as a choice of design.

Claims 1, 11, 26 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee.

Lee discloses a book like structure with an element (10) attached thereto. The element (10) may include a tether (82). The element is physically capable of being teathed.

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Claim 36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Remarks

Applicant's arguments are generally to the effect that the element (10) of Lomas is not a teething element, and that the examiner must give patentable weight to every recitation in the claim that refers to teething.

Such arguments are not entirely correct. When applicant refers to a "teething element", the term "teething" serves as a recitation of intended usage for the element. Contrary to applicant's argument, the word "teething" does not attribute a structural limitation to the element, since the word "teething" is a verb referring to an action by a child, not a mechanical structure.

When applicant uses terminology such as "teething means", patentable weight is attributed to the intended usage of teething, as required by current case law interpretation. However, any structure which is capable satisfying the function of teething would read as a "teething element". Since the element of Lomas is in fact physically capable of being teethed upon, it would satisfy the function of teething, and thus read as a "teething means".

Applicant also argues that the element of Lomas includes a staple, and thus includes sharp edges. However, the element (10) itself does not include any sharp edges, and thus

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anticipates the claims. It is worth noting that the examiner does not consider the entire set of structures in Lomas to be the element (10), and there is no requirement in the law that the examiner read every single structure in a prior art disclosure as anticipating a single element in a claim.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
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